

REMARKS

This is an amendment under 37 CFR §1.116. The amendments and remarks herein, to the extent they were not presented earlier, are now presented because they are necessitated by the arguments made by the Examiner in the last office action. It is submitted that these amendments do not raise new issues and do not require any further searching. Since this amendment is being filed within two months of the mailing date of the final rejection, an advisory action is respectfully requested. Claims 30-47 are in this application. Claims 30, 31, 36, 38, and 40 have been amended. Claims 43-47 have been added. Claims 1-29 have been cancelled.

The Examiner objected to the specification because the specification does not provide a Background of the Invention and a Brief Summary of the Invention. With respect to the Brief Summary of the Invention, the Examiner cited MPEP §608.01(d) which, in turn, cites 37 CFR §1.73. Applicant notes, however, that 37 CFR §1.73 states "a brief summary of the invention . . . should precede the detail description." Since the operative word in this instance is "should" (as opposed to shall or must), there is no requirement that a Summary of the Invention section be included within a patent application.

With respect to the Background of the Invention, the Examiner cited MPEP §608.01(c) which, in turn, states that the "specification should set forth the Background of the Invention in two parts." Further, applicant can find nothing within 37 CFR §1.71 which requires that a Background of the Invention section must be included within a patent application. Thus, from what applicant can determine, there is no requirement to include a Background of the Invention or a Summary of the Invention within a patent application. As a result, applicant has opted to omit these sections.

The Examiner rejected claims 26-29 and 36-37 under 35 U.S.C. §103(a) as being unpatentable over Iniewski et al. (U.S. Patent No. 6,104,277). The Examiner

also rejected claims 31-32 under 35 U.S.C. §103(a) as being unpatentable over Iniewski et al. in view of Huang et al. (U.S. Patent No. 5,721,166). In addition, the Examiner objected to claim 30 as being dependent upon a rejected base claim, but indicated that this claim would be allowable if rewritten to be in independent form including all of the limitations of the base claim and any intervening claims.

As noted above, claims 26-29 have been cancelled. Claim 30 has been amended to be in independent format, and is believed to include all of the limitations of the base claim and any intervening claims. Claims 31 and 36 have been amended to depend from claim 30, while claims 32 and 37 depend from claims 31 and 36, respectively.

In addition, withdrawn claims 33-35 and 38-42 have been rejoined. Claims 38 and 40 have been amended to depend from claim 30. As a result, claims 33-35 and 38-42 depend either directly or indirectly from allowable claim 30. However, independent claim 30 must be generic if dependent claims 33-35 and 38-42 are considered to be directed to different species.

Applicant notes that the purpose of restriction practice is to prevent a patent from issuing that claims more than one invention. However, it is not possible for a dependent claim to be directed to an invention which is different from the invention recited in the independent claim. For example, in an infringement analysis, if an accused device does not infringe an independent claim, it is not possible for the accused device to infringe any of the dependent claims. As a result, if independent claim 30 and dependent claims 33-35 and 38-42 are considered to be directed to different species, then independent claim 30 must be generic to the species claims that depend from it.

Generic claims are further discussed in MPEP §806.04(d). For example, when a number of figures illustrate a corresponding number of species, a generic claim should read on each of the figures. In the present case, if FIGS. 1A/1B, 1C/1D,

2A/2B, and 2C/2D were considered to illustrate four species, then claim 30 reads on each of these figures.

Further, the cited section of the MPEP states that a generic claim should include no material element additional to those recited within the species claims, and must comprehend within its confines the organization covered in each of the species. However, it is not possible for an independent claim to recite any element which is not recited in a dependent claim. Also, an independent claim always comprehends within its confines the organization covered in each dependent claim.

Independent/dependent claims can have only one of three relationships. In the first case, both claims read on a single species, with the dependent claim further limiting the single species claimed in the independent claim. In the second case, the independent claim reads on multiple species, and is therefore a genus claim, while the dependent claim also reads on multiple species, and is therefore also a genus claim, which further limits the independent claim. In the third case, the independent claim reads on multiple species, and is therefore a genus claim, while the dependent claim reads on a species that further limits the genus claim. It is not possible for independent/dependent claims to have any other type of relationship.

Each of these three cases is permitted in a single national case. 37 CFR §1.141 specifically addresses the third case, allowing more than one species of an invention to be claimed in one national application provided the application also includes an allowable claim generic to all the claimed species and all the claims to the species in excess of one are written in dependent form. Thus, since claims 33-35 and 38-42 depend from an allowed independent claim, claims 33-35 and 38-42 have been properly rejoined.

New claim 43 has been added, and is believed to be patentable for the same reasons as claim 30. New claims 44-47 depend from claim 43 and are believed to be patentable for the same reasons as claim 43.

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Thus, for the foregoing reasons, it is submitted that the application is in a condition for allowance. Therefore, the Examiner's early re-examination and reconsideration are respectively requested.

Respectfully submitted,

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AMENDMENT UNDER 37 CFR §1.116,  
EXPEDITED PROCEDURE REQUESTED

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